

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): Barton et al.
Appl. No.: 10/691,806
Conf. No.: 6662
Filed: October 21, 2003
Title: APPARATUS AND METHOD FOR PROVIDING POINT OF PURCHASE
PRODUCTS
Art Unit: 3653
Examiner: J. Shapiro
Docket No.: 112703-294

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Sir:

This Response is submitted in reply to the Notice of Non-Compliant Appeal Brief dated August 16, 2006.

REMARKS

In response to the Notice of Non-Compliant Appeal Brief dated August 16, 2006, Appellants have corrected the Evidence Appendix of the Appeal Brief to address the informality cited by the Patent Office. The compliant version of the Appeal Brief is attached as Exhibit A without copies of the cited references, which were previously submitted.

Appellants submit that the present Appeal Brief is compliant under 37 CFR 41.37. Appellants respectfully request reconsideration of the Appeal Brief and submit that the Patent Office has failed to establish a *prima facie* case of obviousness with respect to the rejection of the claimed invention. Accordingly, Appellants respectfully submit that the obviousness rejection is erroneous in law and in fact and should therefore be reversed.

The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-294 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett
Reg. No. 30,142
Customer No. 29156

Dated: August 22, 2006

EXHIBIT A

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on February 1, 2005. This Appeal is taken from the Final Rejection in the Office Action dated December 15, 2004.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on appeal is Wm. Wrigley Jr. Company by virtue of an Assignment dated 2/16/05 and recorded at reel 015726, frame 0129 in the United States Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Applicants filed a Notice of Appeal on November 20, 2003 and an Appeal Brief on January 19, 2004 for U.S. Pat. Application Serial No. 09/960,915, from which the currently appealed application is a divisional of. Applicants filed a Notice of Appeal on February 1, 2005 and an Appeal Brief on April 1, 2004 for U.S. Pat. Application Serial No. 10/713,333, which is a continuation of U.S. Pat. Application Serial No. 09/960,915.

III. STATUS OF CLAIMS

Claims 44-68, 76 and 102-111 are pending in the above-identified patent application. Claims 1-43, 69-75 and 77-97 have been canceled previously. Claims 98-101 have been withdrawn previously. Claims 44-68, 76 and 102-111 stand rejected. Therefore, Claims 44-68, 76 and 102-111 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

IV. STATUS OF AMENDMENTS

No amendments were made in this application after the final rejection in the Office Action dated December 15, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the drawings and specification for each of the independent and dependent claims is provided as follows:

Independent Claim 44 is directed to a method of operating an automated checkout comprising: allowing a consumer to bring purchasable items to an automated checkout device; allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display; allowing the consumer to select a product from a dispensing device located in juxtaposition to the automated checkout; automatically dispensing the product from the dispensing device in response to the consumer's selection; and automatically adding a cost of the product to the cost for the scanned items on the display (page 6, lines 3-9).

Dependent Claim 45 is directed to the method of Claim 44, wherein the consumer selects the product by using a touch screen (page 19, lines 3-10).

Dependent Claim 46 is directed to the method of Claim 44, including the step of allowing the consumer to pay for the product by credit/debit card (page 15, lines 4-5).

Dependent Claim 47 is directed to the method of Claim 44, wherein adding the cost of the product includes automatically increasing a balance due on a credit/debit card transaction (page 33, line 24 to page 34, line 2).

Independent Claim 48 is directed to a method of operating a checkout station comprising: allowing a consumer to bring purchasable items to a store operator; allowing the operator to scan the purchasable items and accumulate a cost for the scanned items; allowing the consumer to independently purchase a product by touching a screen coupled to a dispensing device; dispensing the product from the dispensing device in response to the consumer touching the screen, the dispensing device being located at the checkout station and thereby storing product at the checkout station; and automatically adding a cost of the dispensed product to the cost for the scanned items (page 6, lines 10-16).

Independent Claim 49 is directed to a method of operating a checkout station comprising: employing an operator to input purchasable items into a device and accumulate a cost for the purchasable items; prompting a consumer to purchase a product from a dispensing device; automatically dispensing the product from the dispensing device upon the consumer's request;

and automatically adding a cost of the product to the cost for the purchasable items (page 6, lines 17-21).

Independent Claim 50 is directed to a method for providing a point of purchase product without the need for a cashier comprising: providing a checkout area for the consumer to bring items for purchase; accumulating a cost associated with the items the consumer wants; providing a product at the point of purchase; prompting the consumer that other product is available at the point of purchase; dispensing the product to the consumer at the point of purchase upon a request by the consumer to purchase the product; and automatically, without need for a cashier, adding to the cost associated with other items purchased any additional cost for the product (page 6, lines 22-28).

Dependent Claim 51 is directed to the method of Claim 50, which includes accepting a single payment in exchange for the product and other purchased items (page 6, lines 29-30).

Dependent Claim 52 is directed to the method of Claim 50, wherein the consumer is prompted that the product is available by an advertisement for the product (page 6, lines 31-32).

Dependent Claim 53 is directed to the method of Claim 50, wherein prompting the consumer includes prompting the consumer at a time selected from the group consisting of: before the consumer purchases the other consumable items, while the consumer is purchasing the other items and after the consumer purchases the other items (page 7, lines 1-2 and page 36, lines 10-21).

Dependent Claim 54 is directed to the method of Claim 50, which includes allowing a retail operator to enter the consumer's approval to purchase the product (page 7, lines 3-4).

Dependent Claim 55 is directed to the method of Claim 50, which includes allowing the consumer to enter the approval to purchase the product (page 7, lines 5-6).

Independent Claim 56 is directed to a method for providing different products at a point-of purchase comprising: stocking a plurality of different products at the point of purchase; automatically prompting the consumer that the products are available at the point of purchase; automatically accepting an approval by the consumer to purchase at least one of the products; automatically dispensing the at least one the product to the consumer at the point of purchase; and automatically adding to the cost of the product to the cost of any other items that are being purchased (page 7, lines 7-15).

Dependent Claim 57 is directed to the method of Claim 56, wherein prompting the consumer that the products are available includes displaying a dynamic display selected from the group consisting of: a display of the products, a message concerning the products, an advertisement concerning the products and a price reduction concerning the products (page 7, lines 16-17 and page 18, lines 17-30).

Dependent Claim 58 is directed to the method of Claim 56, which includes allowing a retail operator to enter the consumer's approval to purchase the at least one product (page 7, lines 3-4).

Dependent Claim 59 is directed to the method of Claim 56, which includes allowing the consumer to enter the approval to purchase the at least one product (page 7, lines 5-6).

Independent Claim 60 is directed to a method for providing consumable and non-consumable products at the same location comprising: stocking consumable and non-consumable products in a single device; allowing a consumer to purchase a consumable product from the single device without the need for a cashier; allowing the consumer to purchase a non-consumable product from the single device without the need for a cashier; dispensing the consumable and non-consumable product to the consumer at the same location in the device; and allowing the consumer to pay for the consumable and non-consumable product without the need for money (page 7, lines 18-24).

Dependent Claim 61 is directed to the method of Claim 60, which includes allowing the consumer to pay for the consumable and non-consumable product at one time (page 7, lines 25-26).

Independent Claim 62 is directed to a method of generating revenue comprising: providing a point of purchase device that is coupled to the retail purchasing device, the point of purchase device designed to dispense a product at the point of purchase; and obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed from the point of purchase device (page 7, lines 27-30).

Dependent Claim 63 is directed to the method of Claim 62, wherein the point of purchase device is integral with the retail purchasing device (page 32, lines 1-8).

Dependent Claim 64 is directed to the method of Claim 62, wherein the retail purchasing device is selected from the group consisting of: a self-scanning purchasing device, a fuel dispensing gasoline pump, a debit/credit card reader and a cash register (page 8, lines 1-3).

Independent Claim 65 is directed to a method for purchasing items comprising the steps of transporting a plurality of items to a checkout station; using a device that identifies costs for the items to create a purchase price for the plurality of items; prompting a consumer to purchase a point of purchase product; dispensing from a dispenser the point of purchase product; and automatically, without the need for a human operator, adding the cost of the point of purchase product to the purchase price (page 8, lines 6-11).

Dependent Claim 66 is directed to the method of Claim 65, wherein the cost of the point of purchase product is added to the purchase price before the cost of all of the plurality of items is totaled (page 8, lines 12-13).

Dependent Claim 67 is directed to the method of Claim 65, wherein the device that identifies costs is an optical scanner (page 8, line 14).

Dependent Claim 68 is directed to the method of Claim 65, wherein the point of purchase product is dispensed from a device that is integral with the device that identifies costs (page 8, lines 15-16).

Independent Claim 76 is directed to a method for dispensing a point of purchase product comprising the steps of: providing a purchasable item and a point of purchase product for sale to a retail customer; storing the point of purchase product at a point of purchase location for the purchasable item; inputting a customer selection for the point of purchase product to a retail customer terminal proximate the point of purchase location for the purchasable item, the retail customer terminal adapted to process the customer selection for the point of purchase product and a customer selection for the purchasable item; processing the customer selection for the point of purchase product for electrical communication with a point of purchase dispenser proximate the point of purchase location for the purchasable item; and dispensing the point of purchase product to the customer from the point of purchase dispenser responsive to the electrical communication and adding a cost of the point of purchase product to a purchasable item cost automatically (page 9, lines 1-10).

Independent Claim 102 is directed to a method of operating an automated checkout comprising: allowing a consumer to bring purchasable items to an automated checkout device; allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display; allowing the consumer to select, by touching the display, a product from a dispensing device that stores and dispenses product at a location that is in juxtaposition to an area

that a consumer occupies as he operates the automated checkout; automatically dispensing the product from the dispensing device in response to the consumer touching the display; and automatically including, without the need for a cashier, a cost of the product with the cost for the scanned items on the display in response to the consumer touching the display (page 6, lines 3-9 and page 19, lines 3-10).

Dependent Claim 103 is directed to the method of Claim 102, wherein the dispensing device is part of the automated checkout (page 36, lines 4-9).

Dependent Claim 104 is directed to the method of Claim 102, including the step of allowing the consumer to pay for the product by credit/debit card (page 5, lines 3-10).

Dependent Claim 105 is directed to the method of Claim 102, wherein the dispensing device is integral with the automated checkout (page 36, lines 4-9).

Independent Claim 106 is directed to a method of operating a checkout station comprising: allowing a consumer to bring purchasable items to a store operator; allowing the operator to scan the purchasable items and accumulate a cost for the scanned items; storing a plurality of point of purchase products in a dispenser at the checkout station; providing a screen that has a dynamic display capable of displaying an advertisement for at least one of the plurality of point of purchase products; allowing the consumer to purchase the point of purchase product by touching the screen; dispensing the product from the dispensing device in response to the consumer touching the screen; and automatically including and adding a cost of the dispensed product to the cost for the scanned items in response to the consumer touching the screen without any other action by the consumer or the operator (page 4, lines 20-26 and page 19, lines 3-10).

Independent Claim 107 is directed to a method of operating a checkout station comprising: employing an operator to input purchasable items into a device and accumulate a cost for the purchasable items; prompting a consumer, through the use of a display, to purchase a plurality of different products from a dispensing device; allowing the consumer to select at least one of the plurality of products by touching a portion of the checkout station; automatically dispensing the product from the dispensing device upon the consumer's touching of a portion of the checkout station; and automatically adding, without any action of the operator, a cost of the product to the cost for the purchasable items in response to the consumer touching a portion of the checkout station (page 4, lines 20-31 and page 19, lines 3-10).

Independent Claim 108 is directed to a method for providing a chewing gum product to a consumer at a checkout area comprising: providing a checkout area that allows a consumer to checkout without the need for a cashier; providing an area for allowing a consumer to bring items the consumer wants to purchase; accumulating a cost associated with the items the consumer wants to purchase; storing a chewing gum product at the point of purchase in a dispenser; prompting the consumer that the chewing gum product is available at the point of purchase; dispensing the chewing gum product to the consumer at the point of purchase in response to the consumer touching a screen; and automatically, without the need for a cashier, adding a cost associated with chewing gum purchased to the cost associated with the items in response to the consumer touching the screen (page 6, lines 22-28 and page 16, lines 9-16).

Independent Claim 109 is directed to a method for providing different products including confectionary products at a point of purchase comprising: stocking a plurality of different confectionary products at the point of purchase; automatically prompting, through the use of a dynamic display, the consumer that the confectionary products are available at the point of purchase; allowing the consumer to select, through the use of the dynamic display, at least one confectionary product to purchase; automatically dispensing the at least one the confectionary product to the consumer at the point of purchase in response to the consumer touching the dynamic display; and automatically adding to the cost of the product to the cost of any other items that are being purchased in response to the consumer touching the dynamic display (page 6, lines 22-28, page 16, lines 9-16, and page 22, lines 7-23).

Independent Claim 110 is directed to a method for providing confectionary and non-consumable products at the same location comprising: stocking confectionary and non-consumable products in a single device; allowing a consumer to purchase a confectionary product from the single device without the need for a cashier; allowing the consumer to purchase a non-consumable product from the single device without the need for a cashier; dispensing the confectionary and non-consumable product to the consumer at the same location; totaling the cost for the confectionary and non-consumable product; and allowing the consumer to pay for the confectionary and non-consumable product without the need for money (page 7, lines 18-24 and page 33, lines 21-31).

Independent Claim 111 is directed to a method for purchasing items comprising the steps of transporting a plurality of items to a checkout station; using a means for identifying costs to

identify the costs for the items and create a purchase price for the plurality of items (page 21, line 26 to page 22, line 14 and Figure 2, elements 30a); providing a means for prompting the purchase of point of purchase products (page 22, lines 7-23 and Figure 2, elements 30a); prompting through the use of the means for prompting the purchase a consumer to purchase at least one of a group of point of purchase products (page 22, lines 7-23); allowing the consumer to use the means for prompting the purchase to select one of the group of point of purchase products (page 22, lines 7-23); dispensing from a means for dispensing the point of purchase product (page 24, lines 17-31 and Figure 2, element 54); and automatically, without the need for a human operator, adding the cost of the point of purchase product to the purchase price (page 8, lines 6-11).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the citations below, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 44, 48-50, 56, 65, 67, 76 and 102-111 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,356,794 to Perin et al. ("*Perin*") in view of U.S. Patent No. 6,213,395 to Dejaeger et al. ("*Dejaeger*"). A copy of the Final Rejection is attached as Exhibit A. A copy of *Perin* and *Dejaeger* is attached herewith as Exhibits B and C, respectively.
2. Claims 45-47, 51-55, 57-61, 66, 68 and 102-111 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Perin* in view of *Dejaeger* and further in view of U.S. Patent No. 6,189,790 to Walter ("*Walter*"). A copy of *Walter* is attached herewith as Exhibit D.
3. Claims 44, 48-50, 56, 65, 67, 76 and 102-111 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,816,443 to Bustos ("*Bustos*") in view of *Walter*. A copy of *Bustos* is attached herewith as Appendix E.

VII. ARGUMENT

A. LEGAL STANDARDS

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome “by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q., 580 (CCPA 1974).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

B. THE REJECTION OF CLAIMS 44, 48-50, 56, 65, 67, 76 AND 102-111 UNDER 35 U.S.C. §103(a) TO PERIN AND DEJAEGER SHOULD BE REVERSED BECAUSE THE PATENT OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF OBVIOUSNESS

1. The Cited References

Appellants respectfully submit that the obviousness rejection of Claims 44, 48-50, 56, 65, 67, 76 and 102-111 should be reversed because the Patent Office fails to establish a *prima facie* case of obviousness. Regarding Claims 44, 48-50, 56, 65, 67, 76 and 102-111, the Patent Office in the Final Office Action dated 12/15/2004 (“Office Action”) at page 2 alleges that the combination of *Perin* and *Dejaeger* renders obvious the claimed invention. However, the Patent Office fails to establish a *prima facie* case of obviousness in each rejection because there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested

and the cited references fail to teach or suggest every element of the claimed invention. Further, in many instances, the Patent Office has not even attempted to provide specific support from the cited references for many novel elements of the claimed invention.

The following discusses in more detail the deficiencies of *Perin* and *Dejaeger* regarding the present claims.

2. There is no suggestion or motivation to combine the cited references to arrive at Appellants' claimed invention

One having ordinary skill would not be motivated to combine or modify the cited references because they teach away from each other. *Dejaeger* is directed towards an automated or self-service checkout. *Perin* fails to disclose or suggest such a device. Indeed, *Perin* teaches away from any type of automated checkout. For example, *Perin* specifically requires a clerk or retail person to operate the dispensing system (via a retailer module) in conjunction with a customer. See, *Perin*, column 7, lines 24-41 and column 13, lines 22-42. In fact, by disclosing an item dispensing system having alarms, *Perin* essentially teaches that a clerk must be present to attend to the dispensing system. See, *Perin*, column 3, lines 1-31. Accordingly, one having ordinary skill in the art would not modify *Perin* to be an automated checkout counter when *Perin*'s disclosure requires a person to constantly operate the item dispensing network system. Thus, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants respectfully submit that it is only with a hindsight reconstruction of Appellants' claimed invention that the Patent Office is able to even attempt to piece together a rejection of the claims. Of course, the Court of Appeals for the Federal Circuit has criticized this motivation to combine analysis (e.g., hindsight reconstruction) because the motivation to combine the references was first disclosed in the present invention. *In re O'Farrell*, 853 F.2d, 894, 902-903 (Fed. Cir. 1988).

3. *Perin and Dejaeger, alone or in combination, fail to teach or suggest every element of the claimed invention*

a. Independent Claim 44

The cited references, alone or in combination, fail to disclose or suggest the present claim. Independent Claim 44 requires, in part, the step of automatically adding a cost of the dispensed product to the cost associated with the scanned items. *Perin* and *Dejaeger* fail to disclose or suggest this feature. In fact, *Perin* and *Dejaeger* fail to disclose anywhere in the specification automatically adding the cost of any dispensed item to the cost of a scanned item. The Patent Office refers in the Office Action to column 4, line 42 and column 5, lines 12-21 of *Perin* as disclosing this element. However, in contrast to the claimed element, this portion of the reference states “if a customer desires to purchase game tickets, the customer pays the clerk with cash or credit card. The amount of the ticket as purchased is entered by the clerk into the retail terminal...” See column 4, lines 42-45, emphasis added. Thus, contrary to the Examiner’s statement, *Perin* teaches away from this element. Further, *Dejaeger* fails to disclose any kind of product dispensing device. For these reasons, the obviousness rejection of Claim 44 is improper.

b. Independent Claim 48

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 48 requires, in part, a touch screen coupled to the dispensing device. *Perin* fails to disclose or suggest any touch screen associated with a dispensing device. *Dejaeger* fails to disclose any kind of product dispensing device. Claim 48 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product. This feature, once again, is taught away from in *Perin*. Consequently, neither *Perin* nor *Dejaeger* discloses or suggests automatically adding the costs of the dispensed product and the scanned product. For these reasons, the obviousness rejection of Claim 48 is improper.

c. Independent Claim 49

The cited references alone, or in combination, fail to disclose or suggest the present claim. In addition to the automatically adding the cost of the product (not disclosed in *Perin* or *Dejaeger*), independent Claim 49 requires prompting the consumer to purchase a product from the dispensing device. Neither *Perin* nor *Dejaeger* discloses or suggests this feature. For these reasons, the obviousness rejection of Claim 49 is improper.

d. Independent Claim 50

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 50 requires, in part, providing a product at the point of purchase and prompting the consumer that other products are available at the point of purchase. These elements are neither disclosed nor suggested by *Perin* or *Dejaeger*. In fact, *Perin* or *Dejaeger* fail to disclose or suggest any prompting of a consumer to purchase products from a dispensing device. Furthermore, this claim requires, automatically, without need for a cashier, adding the cost associated with other items purchased with any additional cost for the point of purchase product. *Perin* and *Dejaeger* fails to disclose same. For these reasons, the obviousness rejection of Claim 50 is improper.

e. Independent Claim 56

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 56 requires, in part, stocking a plurality of different products at the point of purchase. This feature is neither disclosed nor suggested by *Perin* or *Dejaeger*. Additionally, for example, the feature of automatically prompting the consumer that the products are available at the point of purchase is neither disclosed nor suggested by *Perin* or *Dejaeger*. This claim also requires automatically adding to the cost of the product the cost of any other items that are being purchased, which is not disclosed or suggested by *Perin* or *Dejaeger*. For these reasons, the obviousness rejection of Claim 56 is improper.

f. Independent Claim 65

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 65 requires, in part, prompting a consumer to purchase a point of purchase product. *Perin* and *Dejaeger* fail to disclose or suggest this feature. This claim also requires the automatically adding to the cost of the point of purchase product to the cost of any other items that are being purchased, which is not disclosed or suggested by *Perin* or *Dejaeger*. Thus, for at least this reason, the obviousness rejection of Claim 65 is improper.

g. Independent Claim 76

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 76 requires, in part, storing point of purchase products at the point of purchase location. This claim also requires the step of automatically adding the point of

purchase cost to the other cost, which is not disclosed or suggested by *Perin* or *Dejaeger*. For at least these reasons, the obviousness rejection of Claim 76 is improper.

h. Independent Claim 102

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 102 requires, in part, allowing the consumer to select, by touching the display, a product from a dispensing device that stores and dispenses the product. *Perin* fails to disclose or suggest any touch display associated with a dispensing device. *Dejaeger* fails to disclose any kind of product dispensing device. Claim 102 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Perin* or *Dejaeger*. For these reasons, the obviousness rejection of Claim 102 is improper.

i. Independent Claim 106

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 106 requires, in part, providing a screen that has a dynamic display capable of displaying an advertisement for at least one of a plurality of point of purchase products. *Perin* and *Dejaeger* fail to disclose or suggest any dynamic display advertisements associated with the screen and products of a point of purchase device. Claim 106 also includes allowing the consumer to purchase the point of purchase product by touching a screen. *Perin* and *Dejaeger* fail to disclose or suggest any touch screen associated with a point of purchase device. Claim 106 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Perin* or *Dejaeger*. For these reasons, the obviousness rejection of Claim 106 is improper.

j. Independent Claim 107

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 107 requires, in part, prompting a consumer, through the use of a display, to purchase a plurality of different products from a dispensing device. *Perin* and *Dejaeger* fail to disclose or suggest any prompting by a dispensing device. Claim 107 also includes allowing the consumer to select one of the plurality of product from a dispensing device by touching a portion of a checkout station. *Perin* and *Dejaeger* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to

the cost of the purchasable items, which is not disclosed or suggested by *Perin* or *Dejaeger*. For at least these reasons, the obviousness rejection of Claim 107 is improper.

k. Independent Claim 108

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 108 requires, in part, prompting a consumer to purchase a chewing gum from a dispenser. *Perin* and *Dejaeger* fail to disclose or suggest any prompting by a dispenser or even any chewing gum product dispensed by a dispenser. Claim 108 also includes dispensing the chewing gum product to the consumer in response to the consumer touching a screen. *Perin* and *Dejaeger* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the chewing gum product cost to the cost of the other items, which is not disclosed or suggested by *Perin* or *Dejaeger*. For at least these reasons, the obviousness rejection of Claim 108 is improper.

l. Independent Claim 109

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 109 requires, in part, stocking a plurality of different confectionary products at the point of purchase. *Perin* and *Dejaeger* fail to disclose or suggest this feature. Claim 109 requires automatically prompting a consumer, through the use of a dynamic display, to purchase the plurality of confectionary products from a dispensing device. *Perin* and *Dejaeger* fail to disclose or suggest any automatic prompting by a dispensing device. Claim 109 also includes allowing the consumer to select at least one of the confectionary products from a dispensing device by touching the dynamic display. *Perin* and *Dejaeger* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to the cost of the purchasable items, which is not disclosed or suggested by *Perin* or *Dejaeger*. For at least these reasons, the obviousness rejection of Claim 109 is improper.

m. Independent Claim 110

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 110 requires, in part, stocking confectionary and non-consumable products in a single dispensing device. *Perin* and *Dejaeger* fail to disclose or suggest this feature. Claim 110 requires allowing a consumer to purchase the confectionary product or non-consumable product from the dispensing device without the need of a cashier. *Perin* and *Dejaeger* fail to disclose or suggest any such automatic confectionary product and non-

consumable product dispensing device. This claim also requires the step of totaling the cost of the confectionary product with the cost of the non-consumable product, which is not disclosed or suggested by *Perin* or *Dejaeger*. For at least these reasons, the obviousness rejection of Claim 110 is improper.

n. Independent Claim 111

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 111 requires, in part, providing a means for prompting the purchase of point of purchase products. These elements are neither disclosed nor suggested by *Perin* or *Dejaeger*. In fact, *Perin* or *Dejaeger* fail to disclose or suggest any prompting means of a consumer to purchase products from a dispensing device. Furthermore, this claim requires, automatically, without need for a human operator, adding the cost of the point of purchase product to the purchase price of the plurality of items brought to the checkout station, which is not disclosed or suggested by *Perin* or *Dejaeger*. For these reasons, the obviousness rejection of Claim 111 is improper.

C. THE REJECTION OF CLAIMS 45-47, 51-55, 57-61, 66, 68 AND 102-111 UNDER 35 U.S.C. §103(a) TO PERIN, DEJAEGER AND WALTER SHOULD BE REVERSED BECAUSE THE PATENT OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF OBVIOUSNESS

1. The Cited References

Appellants respectfully submit that the obviousness rejection of Claims 45-47, 51-55, 57-61, 66, 68 and 102-111 should be reversed because the Patent Office fails to establish a *prima facie* case of obviousness. Regarding Claims 45-47, 51-55, 57-61, 66, 68 and 102-111 the Patent Office in the Final Office Action dated 12/15/2004 ("Office Action") at page 3 alleges that the combination of *Perin*, *Dejaeger* and *Walter* renders obvious the claimed invention. However, the Patent Office fails to establish a *prima facie* case of obviousness in each rejection because there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested and the cited references fail to teach or suggest every element of the claimed invention. Further, in many instances, the Patent Office has not even attempted to provide specific support from the cited references for many novel elements of the claimed invention.

The following discusses in more detail the deficiencies of *Perin*, *Dejaeger* and *Walter* regarding the present claims.

2. There is no suggestion or motivation to combine the cited references to arrive at Appellants' claimed invention

As discussed above, one having ordinary skill would not be motivated to combine or modify the cited references because they teach away from the each other. *Dejaeger* is directed towards an automated or self-service checkout. *Perin* fails to disclose or suggest such a device. Indeed, *Perin* teaches away from any type of automated checkout. For example, *Perin* specifically requires a clerk or retail person to operate the dispensing system (via a retailer module) in conjunction with a customer. See, *Perin*, column 7, lines 24-41 and column 13, lines 22-42. In fact, by disclosing an item dispensing system having alarms, *Perin* essentially teaches that a clerk must be present to attend to the dispensing system. See, *Perin*, column 3, lines 1-31. Accordingly, one having ordinary skill in the art would not modify *Perin* to be an automated checkout counter when the *Perin's* disclosure requires a person to constantly operate the item dispensing network system. Thus, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Moreover, *Walter* specifically discloses that a self-service checkout (as disclosed by *Dejaeger* and *Walter*) is a system that is operated by a customer without the aid of a retail clerk. See, *Walter*, column 1, lines 21-24. Such disclosure explicitly teaches away from modifying or combining the cited references. "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting*, 139 F.3d at 1009, quoting, *In re Gurley*, 27 F.3d 551. Accordingly, one having ordinary skill in the art would not modify *Perin* to be an automated checkout counter when *Perin's* disclosure requires a person to operate the item dispensing network system.

3. *Perin, Dejaeger and Walter alone or in combination fail to teach or suggest every element of the claimed invention*

a. Dependent Claim 45

Claim 45 that depends from Claim 44 is also allowable for at least substantially the same reasons as Claim 44 as discussed previously. In addition, Claim 45 claims the dispensing device having a touch screen, which is not disclosed in *Perin, Dejaeger* or *Walter*. For example, *Perin* fails to disclose or suggest any touch display associated with a dispensing device. *Dejaeger* and *Walter* fail to disclose any kind of product dispensing device. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 44.

b. Dependent Claim 51

Claim 51 that depends from Claim 50 is also allowable for at least substantially the same reasons as Claim 50 as discussed previously. In addition, Claim 51 claims the step of accepting a single payment in exchange for the dispensed product and other purchased items, which is not disclosed in *Perin, Dejaeger* or *Walter*. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 50.

c. Dependent Claim 52

Claim 52 that depends from Claim 50 is also allowable for at least substantially the same reasons as Claim 50 as discussed previously. In addition, Claim 52 claims the consumer prompted that the product is available by an advertisement for the product, which is not disclosed in *Perin, Dejaeger* or *Walter*. *Walter* fails to disclose same because the product being advertised in the claimed invention is one available from the dispensing device. Because *Walter* does not have a product dispensing device, it cannot advertise such a product. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 50.

d. Dependent Claim 53

Claim 53 that depends from Claim 50 is also allowable for at least substantially the same reasons as Claim 50 as discussed previously. In addition, Claim 53 claims prompting the consumer about products available at the point of purchase at various times, which is not disclosed in *Perin, Dejaeger* or *Walter*. In fact, *Perin, Dejaeger* and *Walter* fail to disclose any prompting features, especially those regarding point of purchase products. Thus, this claim adds

limitations that are not disclosed or suggested in combination with the novel elements of Claim 50.

e. Dependent Claim 55

Claim 55 that depends from Claim 50 is also allowable for at least substantially the same reasons as Claim 50 as discussed previously. In addition, Claim 55 requires allowing the consumer to enter the approval to purchase the point of purchase product, which is not disclosed in *Perin*, *Dejaeger* or *Walter*. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 50.

f. Dependent Claim 57

Claim 57 that depends from Claim 56 is also allowable for at least substantially the same reasons as Claim 56 as discussed previously. In addition, Claim 57 claims displaying a variety of dynamic displays about the point of purchase products when prompting the consumer at the point of purchase, each of which is not disclosed in *Perin*, *Dejaeger* or *Walter*. Further, nothing in *Walter* references or even suggests point of purchase products. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 56.

g. Dependent Claim 59

Claim 59 that depends from Claim 56 is also allowable for at least substantially the same reasons as Claim 56 as discussed previously. In addition, Claim 59 requires allowing the consumer to enter the approval to purchase the point of purchase product, which is not disclosed in *Perin*, *Dejaeger* or *Walter*. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 56.

h. Independent Claim 60

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 60 requires, in part, stocking consumable and non-consumable products in a single dispensing device. *Perin*, *Dejaeger* and *Walter* fail to disclose or suggest this feature. Claim 60 requires allowing a consumer to purchase the consumable product or non-consumable product from the dispensing device without the need of a cashier. In contrast, *Perin*, *Dejaeger* and *Walter* fail to disclose or suggest any such automatic consumable product and non-consumable product dispensing device. This claim also requires the step of dispensing the consumable and non-consumable product at the same location in the dispensing device, which is

not disclosed or suggested by *Perin*, *Dejaeger* or *Walter*. For at least these reasons, the obviousness rejection of Claim 60 is improper.

i. Dependent Claim 66

Claim 66 that depends from Claim 65 is also allowable for at least substantially the same reasons as Claim 65 as discussed previously. In addition, Claim 66 claims the cost of the point of purchase product is added to the purchase price before the cost of all the plurality of items is totaled, which is not disclosed in *Perin*, *Dejaeger* or *Walter*. Further, nothing in *Walter* references or even suggests point of purchase products. Thus, this claim adds limitations that are not disclosed or suggested in combination with the novel elements of Claim 65.

j. Independent Claim 102

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 102 requires, in part, allowing the consumer to select, by touching the display, a product from a dispensing device that stores and dispenses the product. *Perin* fails to disclose or suggest any touch display associated with a dispensing device. *Dejaeger* and *Walter* fails to disclose any kind of product dispensing device. Claim 102 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Perin*, *Dejaeger* or *Walter*. For these reasons, the obviousness rejection of Claim 102 is improper.

k. Independent Claim 106

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 106 requires, in part, providing a screen that has a dynamic display capable of displaying an advertisement for at least one of a plurality of point of purchase products. *Perin*, *Dejaeger* and *Walter* fail to disclose or suggest any dynamic display advertisements associated with the screen and products of a point of purchase device. Claim 106 also includes allowing the consumer to purchase the point of purchase product by touching a screen. *Perin*, *Dejaeger* and *Walter* fail to disclose or suggest any touch screen associated with a point of purchase device. Claim 106 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Perin*, *Dejaeger* or *Walter*. For these reasons, the obviousness rejection of Claim 106 is improper.

l. Independent Claim 107

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 107 requires, in part, prompting a consumer, through the use of a display, to purchase a plurality of different products from a dispensing device. *Perin, Dejaeger* and *Walter* fail to disclose or suggest any prompting by a dispensing device. Claim 107 also includes allowing the consumer to select one of the plurality of product from a dispensing device by touching a portion of a checkout station. *Perin, Dejaeger* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to the cost of the purchasable items, which is not disclosed or suggested by *Perin, Dejaeger* or *Walter*. For at least these reasons, the obviousness rejection of Claim 107 is improper.

m. Independent Claim 108

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 108 requires, in part, prompting a consumer to purchase a chewing gum from a dispenser. *Perin, Dejaeger* and *Walter* fail to disclose or suggest any prompting by a dispenser or even any chewing gum product dispensed by a dispenser. Claim 108 also includes dispensing the chewing gum product to the consumer in response to the consumer touching a screen. *Perin, Dejaeger* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the chewing gum product cost to the cost of the other items, which is not disclosed or suggested by *Perin, Dejaeger* or *Walter*. For at least these reasons, the obviousness rejection of Claim 108 is improper.

n. Independent Claim 109

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 109 requires, in part, stocking a plurality of different confectionary products at the point of purchase. *Perin, Dejaeger* and *Walter* fail to disclose or suggest this feature. Claim 109 requires automatically prompting a consumer, through the use of a dynamic display, to purchase the plurality of confectionary products from a dispensing device. *Perin, Dejaeger* and *Walter* fail to disclose or suggest any automatic prompting by a dispensing device. Claim 109 also includes allowing the consumer to select at least one of the confectionary products from a dispensing device by touching the dynamic

display. *Perin, Dejaeger* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to the cost of the purchasable items, which is not disclosed or suggested by *Perin, Dejaeger* or *Walter*. For at least these reasons, the obviousness rejection of Claim 109 is improper.

o. Independent Claim 110

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 110 requires, in part, stocking confectionary and non-consumable products in a single dispensing device. *Perin, Dejaeger* and *Walter* fail to disclose or suggest this feature. Claim 110 requires allowing a consumer to purchase the confectionary product or non-consumable product from the dispensing device without the need of a cashier. *Perin, Dejaeger* and *Walter* fail to disclose or suggest any such automatic confectionary product and non-consumable product dispensing device. This claim also requires the step of totaling the cost of the confectionary product with the cost of the non-consumable product, which is not disclosed or suggested by *Perin, Dejaeger* or *Walter*. For at least these reasons, the obviousness rejection of Claim 110 is improper.

p. Independent Claim 111

The cited references alone, or in combination, fail to disclose or suggest the present claim. As discussed previously, independent Claim 111 requires, in part, providing a means for prompting the purchase of point of purchase products. These elements are neither disclosed nor suggested by *Perin, Dejaeger* or *Walter*. In fact, *Perin, Dejaeger* and *Walter* fail to disclose or suggest any prompting means of a consumer to purchase products from a dispensing device. Furthermore, this claim requires, automatically, without need for a human operator, adding the cost of the point of purchase product to the purchase price of the plurality of items brought to the checkout station, which is not disclosed or suggested by *Perin, Dejaeger* or *Walter*. For these reasons, the obviousness rejection of Claim 111 is improper.

D. THE REJECTION OF CLAIMS 44, 48-50, 56, 65, 67, 76 AND 102-111 UNDER 35 U.S.C. §103(a) TO BUSTOS AND WALTER SHOULD BE REVERSED BECAUSE THE PATENT OFFICE HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF OBVIOUSNESS

1. The Cited References

Appellants respectfully submit that the obviousness rejection of Claims 44, 48-50, 56, 65, 67, 76 and 102-111 should be reversed because the Patent Office fails to establish a *prima facie* case of obviousness. Regarding Claims 44, 48-50, 56, 65, 67, 76 and 102-111, the Patent Office in the Final Office Action dated 12/15/2004 ("Office Action") at page 7 alleges that the combination of *Bustos* and *Walter* renders obvious the claimed invention. However, the Patent Office fails to establish a *prima facie* case of obviousness in each rejection because there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested and the cited references fail to teach or suggest every element of the claimed invention. Further, in many instances, the Patent Office has not even attempted to provide specific support from the cited references for many novel elements of the claimed invention.

The following discusses in more detail the deficiencies of *Bustos* and *Walter* regarding the present claims.

2. There is no suggestion or motivation to combine the cited references to arrive at Appellants' claimed invention

One having ordinary skill would not be motivated to combine or modify the cited references because *Bustos* teaches away from the claimed invention and there is no motivation for the combination of the references. The principal reference relied upon by the Patent Office is *Bustos*. This reference entirely relates to a product vending system utilizing a pneumatic product delivery. In this regard, as illustrated in Figure 1, the product to be dispensed is stored at a remote location away from the actual dispensing device, which teaches away from the claimed invention. For example, *Bustos* specifically states:

A primary object of the present invention is providing a method and system for merchandising products to customer's situations and at locations where it has previously been inconvenient or expensive to do so. It is a particular object of the present invention

to vend food and other products to consumers at locations at which it may be impractical to store the products and to do so in a way that minimizes the amount of human labor required to sell and deliver the product to the customer. (See, *Bustos*, column 3, lines 43-52.)

Bustos actually teaches one having ordinary skill in the art away from the claimed invention. First, the whole point of *Bustos* is to store product remote from the dispensing device, checkout counter or similar area. This is to save space or because the product needs to be maintained at temperatures other than ambient temperatures. Thus, in contrast to the claimed invention, *Bustos* does not envision storing products proximate to the point of purchase but rather remote thereto. As a result, *Bustos* does not suggest this claimed element as it teaches away from same. Accordingly, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, *Bustos* is not concerned with the problem solved by Appellants' claimed invention. *Bustos* illustrates the supermarket prior to the advent of automated or self-scan checkouts. Therefore, *Bustos* is not concerned with providing a method for allowing point-of-purchase products to be dispensed and stored at self-scanning or other self-checkout counters to overcome the problems of limited shelf space for point-of-purchase products. Instead, point-of-purchase products are displayed in *Bustos* as they were prior to self-checkout devices. Consumers can peruse these displays while they wait for the clerk to check them out. Consequently, the issues facing Appellants were not a concern to *Bustos*. It is error to utilize Appellants' recognition of a problem and its solution as a template to recreate the claimed invention. *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Comp., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998). The art itself must provide the motivation for the combination suggested by the Patent Office. In the instant situation such motivation is lacking.

3. *Bustos and Walter Alone or in Combination Fail to Disclose or Suggest a Number of Claimed Features*

a. Independent Claim 44

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 44, for example, requires allowing the consumer to select a product from a dispensing device located in juxtaposition to the automated checkout. *Bustos* fails to disclose or suggest this feature and in fact teaches away from this concept in that it requires remote storage of the products away from the actual dispenser. See, *Bustos*, column 3, lines 43-65. *Walter* fails to disclose any kind of dispensing device. Claim 44 also requires the step of automatically adding a cost of the product to the cost associated with the scanned items. Neither *Bustos* nor *Walter* discloses this feature. Indeed, *Bustos* fails to disclose or even suggest a scanning device or the use of one in conjunction with its invention. For these reasons, the obviousness rejection of Claim 44 is improper.

b. Independent Claim 48

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 48 requires, in part, a touch screen coupled to the dispensing device. *Bustos* fails to disclose or suggest any touch screen associated with a dispensing device. *Walter* fails to disclose any kind of product dispensing device. Claim 48 also requires the step of automatically adding a cost of the dispensed product to the cost of the scanned product. Neither *Bustos* nor *Walter* discloses or suggests the step of automatically adding the costs of the dispensed product and the scanned product. This claim also recites the element of storing the dispensed product at the point of purchase, which is taught away from by *Bustos* and is not disclosed or suggested by *Walter*. For these reasons, the obviousness rejection of Claim 48 is improper.

c. Independent Claim 49

The cited references alone, or in combination, fail to disclose or suggest the present claim. In addition to the automatically adding the cost of the product (not disclosed in *Bustos* or *Walter*), independent Claim 49 requires prompting the consumer to purchase a product from the dispensing device. Neither *Bustos* nor *Walter* discloses or suggests this feature. With respect to *Walter*, it should be noted that to the extent it prompts the consumer to purchase any product, that product is not located at the point of purchase. Indeed, *Walter* discloses the problem

Appellants' claimed invention attempts to overcome, namely the fact that point of purchase products are not provided at automated checkout counters. For these reasons, the obviousness rejection of Claim 49 is improper.

d. Independent Claim 50

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 50 requires, in part, providing a product at the point of purchase and prompting the consumer that other products are available at the point of purchase. These elements are neither disclosed nor suggested by *Bustos* or *Walter*. In fact, *Bustos* or *Walter* fail to disclose or suggest any prompting of a consumer to purchase products from a dispensing device. Furthermore, this claim requires, automatically, without need for a cashier, adding the cost associated with other items purchased with any additional cost for the point of purchase product. *Bustos* and *Walter* fails to disclose same. For these reasons, the obviousness rejection of Claim 50 is improper.

e. Independent Claim 56

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 56 requires, in part, stocking a plurality of different products at the point of purchase. This feature is neither disclosed nor suggested by *Bustos* or *Walter* and is actually taught away from in *Bustos*. Additionally, for example, the feature of automatically prompting the consumer that the products are available at the point of purchase is neither disclosed nor suggested by *Bustos* or *Walter*. This claim also requires the step of automatically adding to the cost of the product the cost of any other items that are being purchased, which is not disclosed or suggested by *Bustos* or *Walter*. For these reasons, the obviousness rejection of Claim 56 is improper.

f. Independent Claim 65

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 65 requires, in part, prompting a consumer to purchase a point of purchase product. *Bustos* and *Walter* fail to disclose or suggest this feature. As discussed previously, with respect to *Walter*, it should be noted that to the extent it prompts the consumer to purchase any product, that product is not located at the point of purchase. This claim also requires the automatically adding to the cost of the point of purchase product to the cost of any

other items that are being purchased, which is not disclosed or suggested by *Bustos* or *Walter*. Thus, for at least this reason, the obviousness rejection of Claim 65 is improper.

g. Independent Claim 76

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 76 requires, in part, storing point of purchase products at the point of purchase location. This feature is neither disclosed nor suggested by *Bustos* or *Walter* and is actually taught away from in *Bustos*. This claim also requires the step of automatically adding the point of purchase cost to the other cost, which is not disclosed or suggested by *Bustos* or *Walter*. For at least these reasons, the obviousness rejection of Claim 76 is improper.

h. Independent Claim 102

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 102 requires, in part, allowing the consumer to select, by touching the display, a product from a dispensing device that stores and dispenses the product. *Bustos* fails to disclose or suggest any touch display associated with a dispensing device. *Walter* fails to disclose any kind of product dispensing device. Claim 102 also requires the step of automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Bustos* or *Walter*. For these reasons, the obviousness rejection of Claim 102 is improper.

i. Independent Claim 106

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 106 requires, in part, providing a screen that has a dynamic display capable of displaying an advertisement for at least one of a plurality of point of purchase products. *Bustos* and *Walter* fail to disclose or suggest any dynamic display advertisements associated with the screen and products of a point of purchase device. Claim 106 also includes allowing the consumer to purchase the point of purchase product by touching a screen. *Bustos* and *Walter* fail to disclose or suggest any touch screen associated with a point of purchase device. Claim 106 also requires the automatically adding a cost of the dispensed product to the cost of the scanned product, which is not disclosed or suggested by *Bustos* or *Walter*. For these reasons, the obviousness rejection of Claim 106 is improper.

j. Independent Claim 107

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 107 requires, in part, prompting a consumer through the use of a display to purchase a plurality of different products from a dispensing device. *Bustos* and *Walter* fail to disclose or suggest any prompting by a dispensing device. Claim 107 also includes allowing the consumer to select one of the plurality of product from a dispensing device by touching a portion of a checkout station. *Bustos* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to the cost of the purchasable items, which is not disclosed or suggested by *Bustos* or *Walter*. For at least these reasons, the obviousness rejection of Claim 107 is improper.

k. Independent Claim 108

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 108 requires, in part, prompting a consumer to purchase a chewing gum from a dispenser. *Bustos* and *Walter* fail to disclose or suggest any prompting by a dispenser or even any chewing gum product dispensed by a dispenser. Claim 108 also includes dispensing the chewing gum product to the consumer in response to the consumer touching a screen. *Bustos* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the chewing gum product cost to the cost of the other items, which is not disclosed or suggested by *Bustos* or *Walter*. For at least these reasons, the obviousness rejection of Claim 108 is improper.

l. Independent Claim 109

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 109 requires, in part, stocking a plurality of different confectionary products at the point of purchase. *Bustos* and *Walter* fail to disclose or suggest this feature, and *Bustos* actually teaches away from this feature. Claim 109 requires automatic prompting a consumer, through the use of a dynamic display, to purchase the plurality of confectionary products from a dispensing device. *Bustos* and *Walter* fail to disclose or suggest any automatic prompting by a dispensing device. Claim 109 also includes allowing the consumer to select at least one of the confectionary products from a dispensing device by touching the dynamic display. *Bustos* and *Walter* fail to disclose or suggest this feature. This claim also requires the step of automatically adding the point of purchase cost to the cost of the purchasable items,

which is not disclosed or suggested by *Bustos* or *Walter*. For at least these reasons, the obviousness rejection of Claim 109 is improper.

m. Independent Claim 110

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 110 requires, in part, stocking confectionary and non-consumable products in a single dispensing device. *Bustos* and *Walter* fail to disclose or even suggest this feature. Claim 110 requires allowing a consumer to purchase the confectionary product or non-consumable product from the dispensing device without the need of a cashier. *Bustos* and *Walter* fail to disclose or suggest any such automatic confectionary product and non-consumable product dispensing device. This claim also requires the step of totaling the cost of the confectionary product with the cost of the non-consumable product, which is not disclosed or suggested by *Bustos* or *Walter*. For at least these reasons, the obviousness rejection of Claim 110 is improper.

n. Independent Claim 111

The cited references alone, or in combination, fail to disclose or suggest the present claim. Independent Claim 111 requires, in part, providing a means for prompting the purchase of point of purchase products. These elements are neither disclosed nor suggested by *Bustos* or *Walter*. In fact, *Bustos* or *Walter* fail to disclose or suggest any prompting means of a consumer to purchase products from a dispensing device. Furthermore, this claim requires, automatically, without need for a human operator, adding the cost of the point of purchase product to the purchase price of the plurality of items brought to the checkout station, which is not disclosed or suggested by *Bustos* or *Walter*. For these reasons, the obviousness rejection of Claim 111 is improper.

VIII. CONCLUSION

Appellants' claimed inventions set forth in Claims 44-68, 76 and 102-111 are neither disclosed, taught nor suggested by the cited references, either alone or in combination. The Patent Office has failed to establish a *prima facie* case of obviousness with respect to the rejection of the claimed invention. For the foregoing reasons, Appellants respectfully request that this Board reverse the obviousness rejection of Claims 44-68, 76 and 102-111 and pass the patent application to allowance.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett
Reg. No. 30,142
Customer No. 29156

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CLAIMS APPENDIX
PENDING CLAIMS ON APPEAL OF
U.S. PATENT APPLICATION SERIAL NO. 10/691,806

Claim 44 (original): A method of operating an automated checkout comprising:
allowing a consumer to bring purchasable items to an automated checkout device;
allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display;
allowing the consumer to select a product from a dispensing device located in juxtaposition to the automated checkout;
automatically dispensing the product from the dispensing device in response to the consumer's selection; and
automatically adding a cost of the product to the cost for the scanned items on the display.

Claim 45 (original): The method of Claim 44, wherein the consumer selects the product by using a touch screen.

Claim 46 (original): The method of Claim 44, including the step of allowing the consumer to pay for the product by credit/debit card.

Claim 47 (original): The method of Claim 44, wherein adding the cost of the product includes automatically increasing a balance due on a credit/debit card transaction.

Claim 48 (previously presented): A method of operating a checkout station comprising:
allowing a consumer to bring purchasable items to a store operator;
allowing the operator to scan the purchasable items and accumulate a cost for the scanned items;
allowing the consumer to independently purchase a product by touching a screen coupled to a dispensing device;

dispensing the product from the dispensing device in response to the consumer touching the screen, the dispensing device being located at the checkout station and thereby storing product at the checkout station; and

automatically adding a cost of the dispensed product to the cost for the scanned items.

Claim 49 (original): A method of operating a checkout station comprising:

employing an operator to input purchasable items into a device and accumulate a cost for the purchasable items;

prompting a consumer to purchase a product from a dispensing device;

automatically dispensing the product from the dispensing device upon the consumer's request; and

automatically adding a cost of the product to the cost for the purchasable items.

Claim 50 (original): A method for providing a point of purchase product without the need for a cashier comprising:

providing a checkout area for the consumer to bring items for purchase;

accumulating a cost associated with the items the consumer wants;

providing a product at the point of purchase;

prompting the consumer that other product is available at the point of purchase;

dispensing the product to the consumer at the point of purchase upon a request by the consumer to purchase the product; and

automatically, without need for a cashier, adding to the cost associated with other items purchased any additional cost for the product.

Claim 51 (original): The method of Claim 50, which includes accepting a single payment in exchange for the product and other purchased items.

Claim 52 (original): The method of Claim 50, wherein the consumer is prompted that the product is available by an advertisement for the product.

Claim 53 (original): The method of Claim 50, wherein prompting the consumer includes prompting the consumer at a time selected from the group consisting of: before the consumer purchases the other consumable items, while the consumer is purchasing the other items and after the consumer purchases the other items.

Claim 54 (original): The method of Claim 50, which includes allowing a retail operator to enter the consumer's approval to purchase the product.

Claim 55 (original): The method of Claim 50, which includes allowing the consumer to enter the approval to purchase the product.

Claim 56 (original): A method for providing different products at a point-of purchase comprising:

stocking a plurality of different products at the point of purchase;

automatically prompting the consumer that the products are available at the point of purchase;

automatically accepting an approval by the consumer to purchase at least one of the products;

automatically dispensing the at least one the product to the consumer at the point of purchase; and

automatically adding to the cost of the product to the cost of any other items that are being purchased.

Claim 57 (original): The method of Claim 56, wherein prompting the consumer that the products are available includes displaying a dynamic display selected from the group consisting of: a display of the products, a message concerning the products, an advertisement concerning the products and a price reduction concerning the products.

Claim 58 (original): The method of Claim 56, which includes allowing a retail operator to enter the consumer's approval to purchase the at least one product.

Claim 59 (original): The method of Claim 56, which includes allowing the consumer to enter the approval to purchase the at least one product.

Claim 60 (original): A method for providing consumable and non-consumable products at the same location comprising:

- stocking consumable and non-consumable products in a single device;
- allowing a consumer to purchase a consumable product from the single device without the need for a cashier;
- allowing the consumer to purchase a non-consumable product from the single device without the need for a cashier;
- dispensing the consumable and non-consumable product to the consumer at the same location in the device; and
- allowing the consumer to pay for the consumable and non-consumable product without the need for money.

Claim 61 (original): The method of Claim 60, which includes allowing the consumer to pay for the consumable and non-consumable product at one time.

Claim 62 (original): A method of generating revenue comprising:
providing a point of purchase device that is coupled to the retail purchasing device, the point of purchase device designed to dispense a product at the point of purchase; and
obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed from the point of purchase device.

Claim 63 (original): The method of Claim 62, wherein the point of purchase device is integral with the retail purchasing device.

Claim 64 (original): The method of Claim 62, wherein the retail purchasing device is selected from the group consisting of: a self-scanning purchasing device, a fuel dispensing gasoline pump, a debit/credit card reader and a cash register.

Claim 65 (original): A method for purchasing items comprising the steps of:
transporting a plurality of items to a checkout station;
using a device that identifies costs for the items to create a purchase price for the plurality of items;
prompting a consumer to purchase a point of purchase product;
dispensing from a dispenser the point of purchase product; and
automatically, without the need for a human operator, adding the cost of the point of purchase product to the purchase price.

Claim 66 (original): The method of Claim 65, wherein the cost of the point of purchase product is added to the purchase price before the cost of all of the plurality of items is totaled.

Claim 67 (original): The method of Claim 65, wherein the device that identifies costs is an optical scanner.

Claim 68 (original): The method of Claim 65, wherein the point of purchase product is dispensed from a device that is integral with the device that identifies costs.

Claim 76 (previously presented): A method for dispensing a point of purchase product comprising the steps of:

providing a purchasable item and a point of purchase product for sale to a retail customer;
storing the point of purchase product at a point of purchase location for the purchasable item;

inputting a customer selection for the point of purchase product to a retail customer terminal proximate the point of purchase location for the purchasable item, the retail customer terminal adapted to process the customer selection for the point of purchase product and a customer selection for the purchasable item;

processing the customer selection for the point of purchase product for electrical communication with a point of purchase dispenser proximate the point of purchase location for the purchasable item; and

dispensing the point of purchase product to the customer from the point of purchase dispenser responsive to the electrical communication and adding a cost of the point of purchase product to a purchasable item cost automatically.

Claim 102 (previously presented): A method of operating an automated checkout comprising:

- allowing a consumer to bring purchasable items to an automated checkout device;
- allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display;
- allowing the consumer to select, by touching the display, a product from a dispensing device that stores and dispenses product at a location that is in juxtaposition to an area that a consumer occupies as he operates the automated checkout;
- automatically dispensing the product from the dispensing device in response to the consumer touching the display; and
- automatically including, without the need for a cashier, a cost of the product with the cost for the scanned items on the display in response to the consumer touching the display.

Claim 103 (previously presented): The method of Claim 102, wherein the dispensing device is part of the automated checkout.

Claim 104 (previously presented): The method of Claim 102, including the step of allowing the consumer to pay for the product by credit/debit card.

Claim 105 (previously presented): The method of Claim 102, wherein the dispensing device is integral with the automated checkout.

Claim 106 (previously presented): A method of operating a checkout station comprising:
allowing a consumer to bring purchasable items to a store operator;
allowing the operator to scan the purchasable items and accumulate a cost for the scanned items;
storing a plurality of point of purchase products in a dispenser at the checkout station;

providing a screen that has a dynamic display capable of displaying an advertisement for at least one of the plurality of point of purchase products;

allowing the consumer to purchase the point of purchase product by touching the screen;

dispensing the product from the dispensing device in response to the consumer touching the screen; and

automatically including and adding a cost of the dispensed product to the cost for the scanned items in response to the consumer touching the screen without any other action by the consumer or the operator.

Claim 107 (previously presented): A method of operating a checkout station comprising:
employing an operator to input purchasable items into a device and accumulate a cost for the purchasable items;

prompting a consumer, through the use of a display, to purchase a plurality of different products from a dispensing device;

allowing the consumer to select at least one of the plurality of products by touching a portion of the checkout station;

automatically dispensing the product from the dispensing device upon the consumer's touching of a portion of the checkout station; and

automatically adding, without any action of the operator, a cost of the product to the cost for the purchasable items in response to the consumer touching a portion of the checkout station.

Claim 108 (previously presented): A method for providing a chewing gum product to a consumer at a checkout area comprising:

providing a checkout area that allows a consumer to checkout without the need for a cashier;

providing an area for allowing a consumer to bring items the consumer wants to purchase;

accumulating a cost associated with the items the consumer wants to purchase;

storing a chewing gum product at the point of purchase in a dispenser;

prompting the consumer that the chewing gum product is available at the point of purchase;

dispensing the chewing gum product to the consumer at the point of purchase in response to the consumer touching a screen; and

automatically, without the need for a cashier, adding a cost associated with chewing gum purchased to the cost associated with the items in response to the consumer touching the screen.

Claim 109 (previously presented): A method for providing different products including confectionary products at a point of purchase comprising:

stocking a plurality of different confectionary products at the point of purchase;

automatically prompting, through the use of a dynamic display, the consumer that the confectionary products are available at the point of purchase;

allowing the consumer to select, through the use of the dynamic display, at least one confectionary product to purchase;

automatically dispensing the at least one the confectionary product to the consumer at the point of purchase in response to the consumer touching the dynamic display; and

automatically adding to the cost of the product to the cost of any other items that are being purchased in response to the consumer touching the dynamic display.

Claim 110 (previously presented): A method for providing confectionary and non-consumable products at the same location comprising:

stocking confectionary and non-consumable products in a single device;

allowing a consumer to purchase a confectionary product from the single device without the need for a cashier;

allowing the consumer to purchase a non-consumable product from the single device without the need for a cashier;

dispensing the confectionary and non-consumable product to the consumer at the same location;

totaling the cost for the confectionary and non-consumable product; and

allowing the consumer to pay for the confectionary and non-consumable product without the need for money.

Claim 111 (previously presented): A method for purchasing items comprising the steps of:

- transporting a plurality of items to a checkout station;
- using a means for identifying costs to identify the costs for the items and create a purchase price for the plurality of items;
- providing a means for prompting the purchase of point of purchase products;
- prompting through the use of the means for prompting the purchase a consumer to purchase at least one of a group of point of purchase products;
- allowing the consumer to use the means for prompting the purchase to select one of the group of point of purchase products;
- dispensing from a means for dispensing the point of purchase product; and
- automatically, without the need for a human operator, adding the cost of the point of purchase product to the purchase price.

EVIDENCE APPENDIX

Office Action dated December 15, 2004 (Exhibit A)

U.S. Patent No. 6,356,794 ("*Perin*"), cited by the Examiner in the Office Action dated December 15, 2004 (Exhibit B)

U.S. Patent No. 6,213,395 ("*Dejaeger*"), cited by the Examiner in the Office Action dated December 15, 2004 (Exhibit C)

U.S. Patent No. 6,189,790 ("*Walter*"), cited by the Examiner in the Office Action dated December 15, 2004 (Exhibit D)

U.S. Patent No. 5,816,443 ("*Bustos*"), cited by the Examiner in the Office Action dated December 15, 2004 (Exhibit E)

RELATED PROCEEDINGS APPENDIX

None